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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY/DOCKET NO.	CONFIRMATION NO.
09/934,390	08/21/2001	William Peter Van Antwerp	G&C 130.15-US-D1	8366

7590 03/31/2004

Attention of William J. Wood  
Gates & Cooper LLP  
Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045

EXAMINER
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WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3736

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DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/934,390

Applicant(s)

VAN ANTWERP ET AL.

Examiner

Eric F Winakur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003 and 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-28 and 30-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-28, 30-33, 36-40, 42-47, 49 and 50 is/are rejected.
- 7) ☒ Claim(s) 34, 35, 41 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21 - 28, and 31 - 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al. Cox et al. teach a fluorescent probe for measuring concentrations of fluid constituents that includes an immobilized fluorophor (9,10-diphenyl anthracene) in a PHEMA or silicone matrix (see Summary of the Invention). A catalyst/enzyme can also be immobilized in the matrix to allow measurement of analytes; in particular, glucose oxidase allows measurement of glucose concentrations (column 12, line 14 - column 13, line 19). The probe can be in various arrangements (see Figures 8 - 10, 19, 21 and descriptions thereof in columns 10 and 12 - 13).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. as applied to claims 21 and 32 above. Figure 19 shows two optical sensors retained within a member, but does not disclose the particular materials used to construct the

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retaining member. Without a showing of unexpected results or criticality, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a well known material having desirable mechanical properties, such as those set forth in the claim, to use when constructing the retaining member, since it has generally been held to be within the skill level of the art to utilize materials for their known purposes.

5. Claims 21, 36 - 40, 42 - 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. in view of James et al. (GB 2 284 809). Cox et al. teach a fluorescent probe for measuring concentrations of fluid constituents that includes an immobilized fluorophore in a PHEMA or silicone matrix (see Summary of the Invention). The probe can be in various arrangements (see Figures 8 - 10, 21 and descriptions thereof in columns 10 and 13). Although Cox et al. teach a particular fluorescent compound as their embodiment, they indicate that their arrangement has certain advantages in optical measurement probes (column 3, line 12 - column 4, line 27) and that it is suitable for incorporating other fluorophores (column 16, lines 8 - 15). James et al. teach an alternate fluorophore that is a fluorescent phenylboronic acid for detecting saccharides. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cox et al. to use the alternate fluorophore of James et al. in the matrix, since Cox et al. teach that their matrix is suitable for containing alternate fluorophores, such as that of James et al.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 21 - 34, 36 - 40, 42 - 47, 49, and 50 have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

7. Claims 34, 35, 41, and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

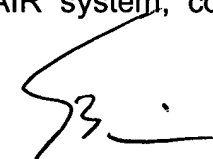
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703/308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur  
Primary Examiner  
Art Unit 3736

22 March 2004